

REMARKS

Currently claims 1-23 are pending in the subject application. Claims 51 and 52 have been withdrawn from subject application. In this regard Applicant would like to point out that Applicant, in the previous response, has maintained the restriction it has not responded to Applicant's arguments in this regard. For the record, Applicant respectfully submit that the claims 51 and 52 are appropriate for the subject application for the reasons previously set forth in Applicant's previous response.

Applicant has amended the claims to more clearly set forth the present invention. In particular, the claims have been amended to specifically point out that the kit is provided to a customer wherein the customer provides hard copy prints and images in a particular manner such that when the service provider obtains the kit from the customer, digital images will be organized into categories in accordance with the instructions and order forms provided by the customer. This type of kit is not taught or suggested in any of the references either individually or in combination as suggested by the Examiner.

The Examiner has maintained the position that the invention is not taught over Nelson for reasons previously set forth. The Examiner submits that Nelson does indeed teach structural limitation of a form having a code. The Examiner then equates the providing of information for organizing of digital images can be accomplished by any code. The Examiner has also submitted that a recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In this regard, Applicant has referred the Examiner to *In re Swinehart* Nsfiligoj 169 USPQ 122 from 1971. Applicant also respectfully refers the Examiner to MPEP 2173.05(g) where functional limitations are discussed. This section of the MPEP specifically endorses the statement in *re Swinehart* that there is nothing inherently wrong with defining some part of an invention in functional terms. In that the functional limitation must be evaluated and considered, just like any other limitation of the claim for what it fairly conveys to a person of ordinary skill in the art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or

purpose that is served by the recited element, ingredient or step. As further set forth in MPEP "In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as 'members adapted to be positioned' and 'portions...being resiliently dilatable whereby said housing may be slidably positioned' serve to precisely define present structural attributes of interrelated component parts of the claimed assembly."

Thus, it can be seen that it is well recognized even with respect to kit claims, that the individual components can have functional limitations that are patentably distinct. There is no teaching or suggestion in Nelson that the bars 18 do other than communicate the method of payment (see column 3, lines 7 and 8). The Nelson reference is simply directed to receiving an order form. There is no functional relationship with any hard copy prints as taught and claimed by Applicant or providing information for organizing the digital images in the groups and categories as set forth by independent claim 1. Claim 1 has also been amended to state that the hard copy prints have images thereon. Applicant would also like to point out that claim 1, as originally filed, discussed that the digital images were obtained by scanning of the hard copy prints. Thus, it is clear that the hard copy prints do indeed include images.

As previously noted, the code provides functional limitations with regard to how the code is used and how it relates to the images obtained from scanning of the hard copy prints. Thus, there is a clear functional relationship between what is provided by the code and the information obtained by scanning of the code and the prints provided therewith. The prior art structure, i.e. print bars, do not teach or suggest the providing of the functional limitations as taught and claimed by Applicant. As previously noted, these functional limitations are appropriate subject matter for claiming the subject invention and is not taught or suggested by Nelson or any of the other references cited by the Examiner. The limitations set forth by Applicant's invention are not merely intended use, but provide structural functional limitations which are appropriate.

In summary, Applicant respectfully submits that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.